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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,374	10/11/2001	Michel Lazdunski	1479-R-00	1246

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IP DEPARTMENT OF PIPER RUDNICK LLP  
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18TH AND ARCH STREETS  
PHILADELPHIA, PA 19103

EXAMINER

ANGELL, JON E

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 10/07/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/975,374

Applicant(s)

LAZDUNSKI ET AL.

Examiner

J. Eric Angell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

Claims 1-19 are pending in the application and are addressed herein.

#### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3 and 11-13, drawn to a mammalian secreted group XII sPLA<sub>2</sub> amino acid sequence and pharmaceutical composition thereof, classified in class 514, subclass 2.
  - II. Claims 4-5 and 7-13, drawn to a nucleic acid encoding a mammalian secreted group XII sPLA<sub>2</sub> amino acid sequence, a vector comprising said nucleic acid, a host cell transformed with said nucleic acid/vector, probe specific for the nucleic acid, and pharmaceutical compositions of the nucleic acid classified in class 435, subclass 325.
  - III. Claim 6, drawn to an antibody, classified in class 530, subclass 387.1.
  - IV. Claim 14, drawn to a method to identify inhibitors of the catalytic activity of sPLA<sub>2</sub>, classified in class 435, subclass 7.21.
  - V. Claim 15, drawn to a method to identify compounds which bind to sPLA<sub>2</sub> receptors, classified in class 435, subclass 7.2.
  - VI. Claim 16, drawn to a method to identify a modulator of cell proliferation, cell migration, cell contraction or apoptosis, classified in class 4.5, subclass 7.8.
  - VII. Claim 17, drawn to a pharmaceutical composition comprising the molecule identified by invention IV, classified in class 514, subclass 2.

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- VIII. Claims 18-19, drawn to a method for treating/preventing infection/cancer comprising using the pharmaceutical composition of invention I (an amino acid sequence), classified in class 514, subclass 2.
- IX. Claims 18-19, drawn to drawn to a method for treating/preventing infection/cancer comprising using the pharmaceutical composition of invention II (a nucleic acid sequence), classified in class 514, subclass 44.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I-III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the three inventions are drawn to products which are chemically, structurally and functionally distinct. For instance the product of Invention I is an amino acid sequence, while the product of Invention II is a nucleic acid sequence which encodes an amino acid sequence, the product of Invention III is an antibody that specifically binds to the amino acid sequence, and the product of invention IV is a composition comprising the molecule identified by the process set forth in Invention IV.

3. Inventions IV, V, VI, VIII and IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together or they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the

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instant case the different inventions utilize different materials and have different modes of operation, different functions, or different desired effects.

4. Inventions I and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product (an amino acid sequence) can be used in a materially different process of use, such as to raise antibodies specific for sPLA<sub>2</sub>.

5. Inventions II and IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Invention II (a nucleic acid sequence) can be used in a materially different process of use, such as to produce the encoded amino acid sequence for purification. Alternatively the nucleic acid sequence of Invention II could be used as a template in a PCR reaction that amplifies the nucleic acid sequence.

6. Inventions III and VII are unrelated to inventions IV, V, VI, VIII and IX. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together or they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP §

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808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects. For instance the antibody of Invention III and the product of Invention VII are not required components of the methods of Inventions IV-VI, VIII and IX.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and the search required for each Group is not required for the other Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Eric Angell whose telephone number is (703) 605-1165. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on (703) 308-0447. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

J. Eric Angell  
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DAVE T. NGUYEN  
PRIMARY EXAMINER

DAVE T. NGUYEN  
PRIMARY EXAMINER